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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/504,117	02/15/2000	Hiroyuki Yamamoto	105311	7485

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EXAMINER

POKRZYWA, JOSEPH R

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 04/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/504,117

Applicant(s)

YAMAMOTO, HIROYUKI

Examiner

Joseph R. Pokrzywa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 28 is/are allowed.
- 6) ☒ Claim(s) 1,2,5-7,10-12,15-17,20,21 and 24-27 is/are rejected.
- 7) ☐ Claim(s) 3,4,8,9,13,14,19,22,23 and 28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. 20050418.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/28/05 has been entered.

Response to Amendment

2. Applicant's amendment was received on 2/28/05, and has been entered and made of record. Currently, **claims 1-28** are pending.

Claim Objections

3. **Claim 16** is objected to because of the following informalities:
in **claim 16**, line 14, "marinating" should read "maintaining".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1, 5, 6, 10, 11, 15, 16, 20, and 24-27** are rejected under 35 U.S.C. 102(b) as being anticipated by Nakayama (U.S. Patent Number 5,084,770).

Regarding *claim 1*, Nakayama discloses a communication apparatus that is capable of selectively attaching transmission information to image information and transmitting, via a communication line, the image information, with or without the transmission information attached to a part thereof (column 5, line 64-column 6, line 24), the communication apparatus comprising an address inputting device for inputting address information of the receiver (column 2, lines 9-21), a setting device for selectively setting one of an attaching transmission information setting or a not-attaching transmission information setting for the address information (column 2, lines 29-55, column 5, lines 10-19, column 6, lines 7-19, and column 8, lines 49-63), a storage device that stores the address information and the selected one of the attaching transmission information setting or not-attaching transmission information setting for the address information (column 2, lines 29-55, column 5, lines 10-28, and column 6, lines 7-19), a transmission information attaching device that attaches the transmission information to the image information if the attaching transmission information setting is stored for the address information (column 5, line 64-column 6, line 19), and a transmission device that transmits the image information with or without the transmission information attached thereto by the

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transmission information attaching device based on the selected one of the attaching transmission information setting or the not-attaching transmission information setting for the address information (column 5, line 64-column 6, line 19), wherein the transmission information includes information of at least one of a transmitter, date and time of transmission, and a number of transmitted pages (see Figs. 6-9).

Regarding *claim 5*, Nakayama discloses the apparatus discussed above in claim 1, and further teaches of a changing device for temporarily overriding the previously stored one of the attaching transmission information setting or the not-attaching transmission information setting for the address information (column 5, line 36-column 6, line 34).

Regarding *claim 6*, Nakayama discloses a communication apparatus that is capable of selectively attaching transmission information to image information and transmitting, via a communication line, the image information, with or without the transmission information attached to a part thereof, to a receiver (column 5, line 52-column 6, line 24), the communication apparatus comprising an address inputting device for inputting an address information of the receiver (column 2, lines 9-21), the address information being at least one of an actual address of the receiver or an abbreviated version of the actual address of the receiver (column 3, lines 21-33, and column 6, lines 36-57), and a transmission information attaching device that selectively attaches the transmission information to the image information to be transmitted to the actual address of the receiver (column 2, lines 29-55, column 5, lines 10-19, column 6, lines 7-19, and column 8, lines 49-63), wherein the transmission information attaching device determines whether to attach or not to attach the transmission information based on the address information (column 2, lines 29-55, column 6, lines 7-19, and column 8, lines 49-63), when the input address

information is the abbreviated version of the actual apparatus (column 3, lines 20-25), the communication apparatus identifies the actual address of the receiver based on the abbreviated version of the actual address and the abbreviated version itself is not another actual address for the receiver (column 3, lines 21-33, and column 6, lines 36-57), and the transmission information includes information of at least one of a transmitter, date and time of transmission, and a number of transmitted pages (see Figs. 6-9).

Regarding *claim 10*, Nakayama discloses the apparatus discussed above in claim 6, and further teaches of a changing device for temporarily overriding the determination made by the transmission information attaching device based on the address information (column 5, line 36-column 6, line 34).

Regarding *claim 11*, Nakayama discloses a communication apparatus that is capable of selectively attaching transmission information to image information and transmitting, via a communication line, the image information, with or without the transmission information attached to a receiver (column 5, line 52-column 6, line 24), the communication apparatus comprising an address inputting device for inputting address information of the receiver (column 2, lines 9-21), a setting device for selectively setting one of an attaching transmission information setting and a not-attaching transmission information setting for the address information (column 2, lines 29-55, column 5, lines 10-19, column 6, lines 7-19, and column 8, lines 49-63), and a transmission information attaching device that attaches the transmission information to the image information if the attaching transmission information setting is set for the address information (column 5, line 64-column 6, line 19), wherein if the address information is set with the attaching transmission information setting, the transmission information attaching

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device attaches the transmission information to the image information (column 2, lines 29-55, column 5, line 10-column 6, line 19, and column 8, lines 49-63), and if the address information is set with the not-attaching transmission setting, the transmission information attaching device does not attach the transmission information (column 2, lines 29-55, column 5, line 10-column 6, line 19, and column 8, lines 49-63), and the transmission information includes information of at least one of a transmitter, date and time of transmission, and a number of transmitted pages (see Figs. 6-9).

Regarding *claim 15*, Nakayama discloses the apparatus discussed above in claim 11, and further teaches of a changing device for temporarily overriding the set one of the attaching transmission information setting or the not-attaching transmission information setting for the address information (column 5, line 36-column 6, line 34).

Regarding *claim 16*, Nakayama discloses a communication apparatus that is capable of selectively attaching transmission information to image information and transmitting, via a communication line, the image information, with or without the transmission information attached to a part thereof, to a receiver (column 5, line 52-column 6, line 24), the communication apparatus comprising an address inputting device for inputting address information of the receiver (column 2, lines 9-21), a setting device for setting, based on the address information, one of an attaching transmission information setting for attaching the transmission information to the image information or a not-attaching transmission information setting for not attaching the transmission information to the image information (column 2, lines 29-55, column 5, lines 10-19, column 6, lines 7-19, and column 8, lines 49-63), a changing device for one of changing or *maintaining* a current setting of one of the attaching transmission information setting or the not

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attaching transmission information setting of the setting device for the address information (column 5, lines 25-49), a transmission information attaching device that determines whether to attach or not to attach the transmission information to the image information based on the setting of the setting device and whether the changing device is set to change or maintain the current setting of the setting device (column 5, line 64-column 6, line 34), and a transmission device that transmits to the receiver the image information with or without the image transmission information attached based on the determination of the transmission information attaching device, according to the address information input by the address inputting device (column 5, line 64-column 6, line 19), wherein the transmission information includes information of at least one of a transmitter, date and time of transmission, and a number of transmitted pages (see Figs. 6-9).

Regarding *claim 20*, Nakayama discloses a communication apparatus that is capable of selectively attaching transmission information to image information and transmitting, via a communication line, the image information, with or without the transmission information attached to a part thereof to a receiver (column 5, line 52-column 6, line 24), the communication apparatus comprising an address inputting device for inputting address information of the receiver (column 2, lines 9-21), a storage device that stores at least one portion of the receiver's address information input by the address inputting device and one of an attaching transmission information setting or a non-attaching transmission information setting for the receiver's address (column 2, lines 29-55, column 5, lines 10-28, and column 6, lines 7-19), a determination device that determines whether the address information of the receiver to whom the image information is to be transmitted, matches previously stored address information in the storage device or

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address information newly input via the address inputting device (column 7, line 14-column 8, line 37), a setting device for selectively setting one of an attaching transmission information setting or a not-attaching transmission information setting for the address information (column 2, lines 29-55, column 5, lines 10-19, column 6, lines 7-19, and column 8, lines 49-63), a transmission information attaching device that attaches or does not attach the transmission information to the image information, based on the determination made by the determination device (column 5, line 64-column 6, line 19), a transmission device that transmits to the receiver the image information, according to the receiver's address information (column 5, line 64-column 6, line 19), wherein if the determination device determines that the address information matches the previously stored address information, the determination device determines which of the attaching transmission information setting or the non-attaching transmission information setting is stored for the address information (column 7, line 14-column 8, line 37), if the determination device determines that the address information is newly input address information, the determination device determines whether to attach or not to attach the transmission information to the image information based on a current setting of an attaching/not attaching transmission information function of the communication apparatus (column 7, line 14-column 8, line 37), wherein the transmission information includes information of at least one of a transmitter, date and time of transmission, and a number of transmitted pages (see Figs. 6-9).

Regarding **claim 24**, Nakayama discloses the apparatus discussed above in claim 20, and further teaches of a changing device for setting the attaching/not attaching transmission information function of the communication device (column 5, line 36-column 6, line 34).

Regarding **claim 25**, Nakayama discloses a communication apparatus that is capable of selectively attaching transmission information to image information and transmitting, via a communication line, the image information, with or without the transmission information attached to a part thereof (column 5, line 64-column 6, line 24), the communication apparatus comprising an inputting device for inputting address information of the receiver (column 2, lines 9-21) and for selecting one of an attaching transmission information setting or a not-attaching transmission information setting for the address information (column 2, lines 29-55, column 5, lines 10-19, column 6, lines 7-19, and column 8, lines 49-63), and a transmission information attaching device that attaches the transmission information to the image information along an outside border of the image information (column 5, line 64-column 6, line 19, see Figs. 6-9), wherein the transmission information attaching device selectively determines to attach or not to attach the transmission information to the image information based on the selected one of the attaching transmission information setting or the not attaching transmission information setting for the address information (column 5, line 64-column 6, line 19).

Regarding **claim 26**, Nakayama discloses the apparatus discussed above in claim 25, and further teaches that transmission information is attached along at least one of a top border and a bottom border of the image information (column 5, line 64-column 6, line 19, see Figs. 6-9).

Regarding **claim 27**, Nakayama discloses the apparatus discussed above in claim 25, and further teaches that transmission information is attached to each page of the image information (column 5, line 64-column 6, line 19, see Figs. 6-9).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 2, 7, 12, 17, and 21** are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakayama (U.S. Patent Number 5,084,770) in view of Kulakowski (WIPO Publication Number WO 97/10668, cited in the Office action dated 8/26/04).

Regarding **claims 2, 7, 12, 17, and 21**, Nakayama discloses the apparatus discussed above in claims 1, 6, 11, 16, and 20, respectively, but fails to expressly disclose if the address information includes a receiver's mail address having an account name and a domain name.

Kulakowski discloses a communication apparatus (interface 10, seen in Figs. 1-3) that transmits, via a communication line, image information, with transmission information attaché to part thereof (see abstract, and Figs. 1 and 5), with the communication apparatus comprising an address inputting device for inputting address information of the receiver (page 12, lines 5 through 14), and a transmission device that transmits the image information with or without the transmission information attached thereto by the transmission information attaching device (page 15, lines 1 through 35), wherein the transmission information includes information of at least one of a transmitter, date and time of transmission, and a number of transmitted pages (page 14, lines 1 through 14, see Fig. 4). Further, Kulakowski teaches that the address information includes a receiver's mail address having an account name and a domain name (page 12, line 5 through page 13, line 10, and page 14, lines 1 through 19).

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Nakayama & Kulakowski are combinable because they are from the same field of endeavor, being facsimile systems that transmit scanned documents. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the teachings Kulakowski in the system of Nakayama. The suggestion/motivation for doing so would have been that Nakayama's system would become more widely used, since user's would be able to transmit facsimile data via the Internet when an e-mail address is input for a destination, as recognized by Kulakowski on page 12. Therefore, it would have been obvious to combine the teachings of Kulakowski with the system of Nakayama to obtain the invention as specified in claims 2, 7, 12, 17, and 21.

Allowable Subject Matter

8. **Claim 28** is allowed.
9. **Claims 3, 4, 8, 9, 13, 14, 18, 19, 22, and 23** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The following is a statement of reasons for the indication of allowable subject matter:

Regarding **claims 3, 4, 8, 9, 13, 14, 18, 19, 22, 23, and 28**, in the examiner's opinion, it would not have been obvious to one of ordinary skill in the art at the time the invention was made to have a systems, as claimed, include the features of having the transmission information device attaching or not attaching the transmission information based on the identified domain name of the receiver.

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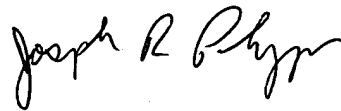
Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (571) 272-7410. The examiner can normally be reached on Monday-Friday, 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph R. Pokrzywa
Primary Examiner
Art Unit 2622



jrj